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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/562,615	07/27/2006	Myung-Hwa Kim	HANOL-10659	6138
72960	7590	08/27/2008		
Casimir Jones, S.C. 440 Science Drive Suite 203 Madison, WI 53711			EXAMINER SZNAIDMAN, MARCOS L	
			ART UNIT	PAPER NUMBER
			1611	
			MAIL DATE	DELIVERY MODE
			08/27/2008	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/562,615

**Applicant(s)**

KIM ET AL.

**Examiner**

MARCOS SZNAIDMAN

**Art Unit**

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-3, 5 and 6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5 and 6 is/are rejected.
- 7) ☒ Claim(s) 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date: \_\_\_\_\_

### **DETAILED ACTION**

This office action is in response to applicant's reply filed on June 3, 2008.

#### ***Election/Restrictions***

Applicant's election without traverse of Group I (claims 1-3 and 5-6) and compound N-[7S-3-ethoxy-1,2-dimethoxy-10-methylsulfanyl-9-oxo-5,6,7,9-tetrahydro-benzo[a]heptalen-7-yl]-2-fluoro-3-nitrooxymethyl-benzamide as the elected species in the reply filed on June 3, 2008 is acknowledged. Since the elected species is free of prior art, examination was expanded to the following species: 4-chloro-N-[5,6,7,9-tetrahydro-1,2,3-trimethoxy-10-(methylthio)-9-oxobenzo[a]heptalen-7-yl]-benzamide (CAS # 147950-73-0).

#### ***Status of Claims***

Cancellation of claim 4 is acknowledged

Claims 1-3 and 5-6 are currently pending and are the subject of this office action.

Claims 1-3 and 5-6 are presently under examination.

#### ***Priority***

The present application is a 371 of PCT/KR04/01518 filed on 06/23/2004.

Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a certified English translation of the

foreign application must be submitted in reply to this action. 37 CFR 41.154(b) and 41.202(e).

Failure to provide a certified translation may result in no benefit being accorded for the non-English application.

### ***Claim Objections***

Claim 3 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following species is being examined: 4-chloro-N-[5,6,7,9-tetrahydro-1,2,3-trimethoxy-10-(methylthio)-9-oxobenzo[a]heptalen-7-yl]-benzamide (CAS # 147950-73-0).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 5 recites an anticancer agent or anti-proliferation agent, containing tricyclic derivatives of any one of claims 1-3. It is not clear whether applicant is claiming a compound or a composition, since an anticancer agent can not comprise a

compound. The phrase: "anticancer agent" defines a property of the compounds of claims 1-3, so it can not comprise a compound of claims 1-3.

Claim 6 recites an angiogenesis inhibitor, containing tricyclic derivatives of any one of claim 1-3. It is not clear whether applicant is claiming a compound or a composition, since an angiogenesis inhibitor can not comprise a compound. The phrase: "angiogenesis inhibitor" defines a property of the compounds of claims 1-3, so it can not comprise a compound of claims 1-3.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-2 and 5-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Guan et. al. (J. Med. Chem. (1988) 41:1956-1961)

Claims 1-2 recite a compound of formula I (see claim 1).). In view of the 112 2<sup>nd</sup> rejection, and for the purpose of the following examination claims 5-6 are being interpreted as compounds.

For claims 1-2 and 5-6 Guan et. al. teach the following compound: 4-chloro-N-[5,6,7,9-tetrahydro-1,2,3-trimethoxy-10-(methylthio)-9-oxobenzo[a]heptalen-7-yl]-

benzamide (CAS # 147950-73-0) (see compound 21 on scheme 1 on page 1958) that reads on general formula I (see claim 1) and all the limitations of claim 2.

### ***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila G. Landau can be reached on 571 272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/MARCOS SZNAIDMAN/  
Examiner, Art Unit 1611  
August 20, 2008

/Sharmila Gollamudi Landau/

Supervisory Patent Examiner, Art Unit 1611